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In re Application of  
BETSON

U.S. Application No.: 10/505,327

Filing Date: 23 August 2004

Attorney Docket No.: M0025.0312/P312

For: AN ACTUATOR

COMMUNICATION

This communication is in response to applicant's "Response to Notification of Missing Requirements Under 35 U.S.C. 371 in The United States Designated/Elected Office (DO/EO/US)" filed 10 February 2005 in the United States Patent and Trademark Office (USPTO) and supplemented by facsimile on 28 February 2005.

**BACKGROUND**

On 21 February 2003, applicant filed international application PCT/IE03/00027. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 28 August 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 August 2004.

On 23 August 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an Information Disclosure Statement and a preliminary amendment.

On 28 January 2005, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of \$65.00 for filing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. (37 CFR 1.492(e)). Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 10 February 2005, applicant filed the present response including an executed declaration.

On 28 February 2005, applicant filed by facsimile copies of two separate PCT/IB/306 forms from the International Bureau (IB) naming Laurence Smyth and Raymond Smyth as

“applicant(s) for all designated States except the United States of America.”

### **DISCUSSION**

The filed declaration does not comply with 37 CFR 1.497(a)-(b) and is thus considered a defective response to the Form PCT/DO/EO/905 mailed 28 January 2005. Specifically, the declaration lists and is executed by two individuals (Laurence Smyth and Raymond Smyth) who are not identified as inventors in the published International Application. According to the furnished IB/306 forms these individuals are not even applicants as to the United States of America. It is possible that the IB improperly processed applicant's PCT Rule 92bis change and that applicant was seeking to add the individuals as inventors in which case amended forms from the IB would be required. If applicant would like to add the named individuals as inventors in the National stage in the United States, applicant should file a petition pursuant to 37 CFR 1.497(d). Absent one of these options it is not possible to continue National stage processing in the United States.

### **CONCLUSION**

Applicant is afforded **ONE (1) MONTH** from the mail date of this communication or the amount of extendable time available from the mail date of the Form PCT/DO/EO/905 to file a proper response as detailed above.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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